

REMARKS

This Amendment is filed in response to the final Office Action mailed February 5, 2008. All objections and rejections are respectfully traversed.

Claims 1-12, 31, 32, and 34-4 are in the case.

Claims 21-30 and 33 have been withdrawn from consideration and have been cancelled, without prejudice, by way of this Amendment.

Claims 34-48 have been added to better claim the invention.

Claims Withdrawn from Consideration

At paragraph 5 of the Office Action, the Examiner withdrew claims 21-30 and 33 from consideration. Accordingly, claims 21-30 and 33 have been cancelled, without prejudice, by way of this Amendment.

Rejections Under 35 U.S.C. § 103(a)

At paragraph 7 of the Office Action, claims 1-12, 31 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Baker et al., U.S. Patent No. 6,473,741 (hereinafter "Baker") in view of Dang et al., U.S. Publication No. 2003/0101111 (hereinafter "Dang").

Applicant's claimed novel invention, as set forth in representative claim 1, as amended, comprises in part:

1. A financial services outsourcing method for facilitating a direct service provider's management of human resources for providing financial services to numerous clients, the financial services being outsourced to an outsourcing group abroad, the method comprising:

prioritizing tax returns for outsourcing;

for plural respective direct services providers, loading, onto a remotely accessible part of a common host server located in a given country, client specific financial files and corresponding reference materials, the host server providing access to a remote computer client of information concerning the client specific financial files and corresponding reference materials;

retaining outsourced personnel to perform tax return preparation services for clients of the direct service providers ***during a tax season in a given year and to perform other financial service projects for the clients of the direct service providers during a different season of the given year***, the outsourced personnel preparing the tax returns and performing the other financial service projects while in an outsource country different from the given country;

providing the outsourced personnel limited access to the server;
the outsourced personnel performing the tax return preparation services during the tax season in the given year and performing the financial service projects during a different season of the given year through a remote limited access client located in the outsource country;
and

monitoring and reporting the status of the tax return preparation and of the other financial service projects.

By way of background, Baker teaches a method and system for aggregation and exchange of income tax data. Baker, column 2, lines 42-44. Specifically, Baker teaches that the income tax data may comprise zip codes, income levels, age of taxpayer, etc. Baker, column 9, lines 47-49. According to Baker, a service bureau acts as the aggregator and conduit of massive quantities of income tax data. Baker, column 9, lines 53-56. Additionally, Baker teaches that the income tax data may be analyzed in massive quantities to obtain surprising and unexpected results (i.e., finding patterns and relationships in the data that are otherwise not readily evident). Baker, column 2, lines 44-51.

Applicant respectfully urges that Baker does not teach or suggest Applicant's claimed novel ***prioritizing tax returns for outsourcing; retaining outsourced personnel to perform tax return preparation services during a tax season in a given year and to perform other financial service projects for the clients of the direct service providers***

during a different season of the given year, and monitoring and reporting the status of the tax return preparation and of the other financial service projects.

Applicant claims a system and method for outsourcing tax return preparation services to a servicing group outside of the country. Specifically, Applicant claims a system and method wherein tax returns requiring preparation are prioritized for outsourcing. In response to prioritization, the tax returns may be outsourced to outsourced personnel and the outsourced personnel may perform tax return preparation services. Applicant further claims a system and method wherein the outsourced personnel may perform other financial service projects during a different season of the year (e.g., a non-tax season). In other words, Applicant claims a system and method for outsourcing the preparation of income tax returns as well as the performance of other financial services. Finally, Applicant claims that the status of the tax return preparation and the status of the other financial services may be monitored and reported.

In contrast, Baker teaches a system and method wherein tax preparation firms submit (e.g., to the service bureau) their databases of income tax data for archival and later retrieval by requesting organizations (i.e., data mining organizations). Baker, column 12, lines 58-65. In other words, Baker teaches that firms submit data from past, completed income tax returns. Baker explains that firms have warehouses of such past income tax data and that the data warehouses are kept to satisfy Internal Revenue Service rules relating to record keeping (e.g., past income tax data). Baker, column 12, line 66 through column 13, line 5. In sharp contrast, Applicant claims a system and method comprising prioritizing tax returns for outsourcing (i.e., not already completed), and retaining outsourced personnel to perform tax return preparation services. Additionally, Applicant claims a system and method for monitoring and reporting the status (e.g., pending completion) of the tax return preparation and of other financial service projects. Baker's teachings and suggestions are directed only to data (i.e., from completed tax returns) and are not directed to the preparation of tax returns. Accordingly, Baker does not teach or suggest Applicant's claimed novel *prioritizing tax returns for outsourcing; retaining outsourced personnel to perform tax return preparation services during a tax*

season in a given year and to perform other financial service projects for the clients of the direct service providers during a different season of the given year, and monitoring and reporting the status of the tax return preparation and of the other financial service projects.

Moreover, Applicant respectfully urges that Dang does not teach or suggest Applicant's claimed novel *prioritizing tax returns for outsourcing; retaining outsourced personnel to perform tax return preparation services during a tax season in a given year and to perform other financial service projects for the clients of the direct service providers during a different season of the given year, and monitoring and reporting the status of the tax return preparation and of the other financial service projects.*

By way of background, Dang teaches a system and method for calculating taxes owed from financial transactions (e.g., sales of goods), and reporting the amount of taxes (e.g., sales taxes) owed to a selected government authority, and periodically remitting funds corresponding to the taxes owed to the government authority over an interactive communications network. Dang ¶ 0009. Dang explains that domestic businesses are usually required by state and local authorities to charge sales and/or use tax for most commercial transactions relating to goods. Dang ¶ 0002. Specifically, Dang teaches a method to enable merchants to electronically outsource the burden of sales tax calculation and remittance of the sales taxes to state-certified service providers. Dang ¶ 0035.

As noted above, Applicant claims a system and method for, *inter alia*, outsourcing income tax preparation (i.e., not sales tax calculation). Applicant respectfully points out to the Examiner that income taxes and sales taxes are incongruent and markedly different in nature. Additionally, Applicant claims a system and method for prioritizing tax returns (i.e., income tax returns) for outsourcing, and retaining outsourced personnel to perform tax return preparation services during a tax season (e.g., the income tax season – sales taxes are not seasonal in nature) in a given year and to perform other financial service projects during a different season of the given year (e.g., not income tax season). Accordingly, Dang does not teach or suggest Applicant's

claimed novel *prioritizing tax returns for outsourcing; retaining outsourced personnel to perform tax return preparation services during a tax season in a given year and to perform other financial service projects for the clients of the direct service providers during a different season of the given year, and monitoring and reporting the status of the tax return preparation and of the other financial service projects.*

There is no motivation to combine Baker and Dang. Baker teaches a method for collecting past income tax data for data mining. Dang, however, teaches a method for electronically outsourcing the tasks of calculation of sales taxes and payment of sales taxes. Baker and Dang teach non-analogous arts (i.e., sales tax calculation and payment is not useful for data mining and data mining is not useful for calculating and paying sales tax). Therefore, Applicant respectfully urges that there is no motivation to combine Baker and Dang.

Even if there was such a motivation, Applicant respectfully urges that Baker and Dang either taken singly or in any combination are legally insufficient to render the presently claimed invention obvious under 35 U.S.C. § 103(a) because of the absence in each of the cited patents of Applicant's claimed novel *prioritizing tax returns for outsourcing; retaining outsourced personnel to perform tax return preparation services during a tax season in a given year and to perform other financial service projects for the clients of the direct service providers during a different season of the given year, and monitoring and reporting the status of the tax return preparation and of the other financial service projects.* Therefore, claims 1-12 are believed to be in condition for allowance.

New Claims

New claims 34-48 were added and are believed to be in condition for allowance.

Applicant's claimed novel invention, as set forth in representative new claim 34, comprises in part:

34. A method comprising:
prioritizing tax returns for outsourcing;
retaining outsourced personnel to prepare the tax returns
prioritized for outsourcing;
providing tax software and tax files to the outsourced personnel;
monitoring work time of the outsourced personnel;
annotating, by the outsourced personnel, the tax returns
prioritized for outsourcing; and
completing, by the outsourced personnel, the tax returns
prioritized for outsourcing.

Applicant respectfully urges that Baker and Dang either taken singly or in any combination do not teach or suggest Applicant's claimed novel *prioritizing tax returns for outsourcing; retaining outsourced personnel to prepare the tax returns prioritized for outsourcing; annotating, by the outsourced personnel, the tax returns prioritized for outsourcing;* and *completing, by the outsourced personnel, the tax returns prioritized for outsourcing.*

Similarly independent claims 41 and 50 also contain Applicant's claimed novel *prioritizing tax returns for outsourcing; retaining outsourced personnel to prepare the tax returns prioritized for outsourcing; annotating, by the outsourced personnel, the tax returns prioritized for outsourcing;* and *completing, by the outsourced personnel, the tax returns prioritized for outsourcing.* Claims 35-40, and 42-49 are dependent claims that are dependent from independent claims which are believed to be allowable for the reasons described above. Accordingly, claims 34-50 are believed to be in condition for allowance.

Conclusion

All claims are believed to be in condition for allowance. Favorable action is respectfully requested.

Please charge any additional fee occasioned by this paper to our Deposit Account
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Respectfully submitted,

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